

DOCKET NO: 265706US0X PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :  
MITSURU TAKEI, ET AL. : EXAMINER: ROBERTS, L.  
SERIAL NO: 10/530,558 :  
FILED: APRIL 7, 2005 : GROUP ART UNIT: 1612  
FOR: DENTAL COATING KIT :

REPLY BRIEF

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

The following Reply Brief is in reply to the Examiner's Answer dated June 2, 2008 (Answer).

The statement of the Grounds of Rejection (Answer at 3-5) is identical to the statement in the Final Rejection, which has already been responded to in the Appeal Brief. The following is in reply to the "Response to Argument" (Answer at 5-10).

The Examiner states that Applicants' arguments in the Appeal Brief are being analyzed in accordance with so-called Guidelines for Examination of Patent Applications under the 35 U.S.C. § 112, paragraph 1 "Written Description" Requirement (Answer at 6). Applicants note that such Guidelines appear as MPEP § 2163.

In reply, Applicants have no dispute with such guidelines to the extent that are consistent with applicable law, but the guidelines do not supersede law. Indeed, MPEP § 2163 specifies that "[t]he Guidelines do not constitute substantive rule-making and hence

do not have the force and effect of law.” Applicants submit that the Examiner has applied the guidelines in a manner inconsistent with law.

The Examiner treats the claims under guidelines labeled 1 through 5 (Answer at 7). Applicants reply to each guideline in the order appearing in the Answer.

Guideline 1

Applicants do not dispute the Examiner’s finding under Guideline 1 (Answer at 7).

Guideline 2

The Examiner finds that the disclosed monomers for the various compositions “overlap substantially in structure” (Answer at 8).

In reply, that there may be overlap has nothing to do with the written description requirement.

The Examiner finds that “there is no real distinction between the compositions themselves” (Answer at 8).

In reply, each composition is recited in terms of what each composition must contain. Applicants have described in the specification examples of each of the particular components recited for each composition recited in the claims. That is more than the written description requirement requires. That Applicants have named these compositions as a primer composition, a coating composition, and a surface smoothing composition, respectively, is simply an indication of the intended function of these compositions. That a coating composition may have a surface smoothing effect, for example, as suggested by the Examiner (Answer at 8), is irrelevant. Finally, since the claims are drawn to a kit, it necessarily follows that each composition is different, without the explicit necessity of reciting same in the claims.

Guideline 3

While the Examiner acknowledges that the examples in the disclosure provide actual reduction to practice, the disclosure “does not provide a full or partial structure of the monomers, nor does it provide a core structure of the monomers that must be present in order for the monomer to be suited for the desired function of each composition ...” (Answer at 8-9).

In reply, the Examiner appears to be conflating compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, with compliance with the written description requirement. It is well-settled that the written description and enablement requirements are independent. See, for example, *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991). The claims clearly comply with the enablement requirement.

A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. §112, first paragraph, unless there is a reason to doubt the objective truth of the statement contained therein which must be relied on for enabling support. The first paragraph of 35 U.S.C. §112 requires nothing more than objective enablement. See *In re Marzocchi*, 439 F. 2d 220, 169 USPQ 367 (CCPA 1971), and M.P.E.P. 2164.04. The Examiner has set forth **no** reasons why one skilled in the art would doubt the truth of any statement in Applicants' disclosure.

Guideline 4

While the Examiner finds that “[a]ll the claims recite monomers in general terms” (Answer at 9), Applicants reply that the monomers are recited as “acidic group-containing monomer (a)”, “monomer (d)” and “polyfunctional monomer (f)”.

#### Guideline 5

The Examiner's findings are similar to those under Guideline 3, above (Answer at 9-10). In finding that Applicants fail to disclose "how to choose monomers that may be used for each of the compositions" (Answer at 9-10), that "there is no clear line of demarcation" between monomers of the respective compositions (Answer at 10), that "because of the open language that is used in the claims, one would not be able to determine if the recited monomer was the photopolymerizable monomer or if there was an additional monomer in the composition that acted as a photopolymerizable monomer" (Answer at 10), that "it appears that the specification only provides a limited number of compositions, which do not appear to be a representative set of all the combination of compositions encompassed by the instant claims" (Answer at 10), are all findings regarding the enablement requirement. See *Marzocchi, supra*. The present claims comply with *Marzocchi*.

#### Conclusion

As is well-known, it is well-settled that the test for compliance with the written description requirement is whether, as an issue of fact, a person skilled in the art would reasonably conclude from a disclosure whose filing date is being relied on that the inventor had possession as of that date of the claimed invention, and how the disclosure accomplishes this fact is unimportant. *Vas-Cath, supra*. The words of the present claims, with clerical corrections, appear in the disclosure as filed. Indeed, it is well-established that an original claim constitutes its own written description. *In re Koller*, 613 F.2d 819, 204 USPQ 702 (CCPA 1980). While the present claims are not original claims, they are of the same scope as the original claims, various formalities having been corrected therein during prosecution below.

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Reply Brief

Applicants continue to maintain that the rejection should be REVERSED.

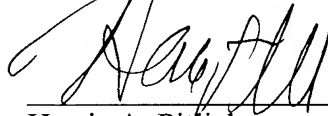
Customer Number

**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 08/07)

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
Norman F. Oblon

A handwritten signature in black ink, appearing to read "H. Pitlick", is written over a horizontal line.

Harris A. Pitlick  
Registration No. 38,779